

REMARKS

By this Amendment, Applicants amend claims 1 and 12, and cancel claim 2 without prejudice and disclaimer to the subject matter thereof. Claims 1 and 3-13 remain currently pending.

In the Office Action, the Examiner allowed claims 6-11 and 13. The Examiner rejected claims 1, 2, and 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,201,968 to Ostroff et al. ("Ostroff") in view of U.S. Patent Application Publication No. 2003/0078043 to Horwath et al. ("Horwath"); rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Horwath and further in view of U.S. Patent No. 5,854,981 to Wallstedt et al. ("Wallstedt"); and rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Horwath and further in view of U.S. Patent No. 6,112,089 to Satarasinghe ("Satarasinghe").¹

Applicants thank the Examiner for allowing claims 6-11 and 13. Applicants respectfully traverse the Examiner's rejection of claims 1, 2, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Horwath, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

Independent claim 1, as amended, recites a combination including, for example, “wherein the first neighbor list and the second neighbor list are combined without determining characteristics of the serving base station and corresponding cell, and the memory stores the first neighbor list until a total number of occasions in which selection for selecting the hand-off destination candidate is performed reaches a preset value, and the first neighbor list is erased from the memory after the total number of occasions reaches the preset value.”² Ostroff fails to teach or suggest at least these features of amended claim 1.

Ostroff teaches “[w]hen the subscriber unit (405) obtains a new neighbor cell list (442) from the cell site (428), it determines whether characteristics of the cell site (428) is such that the new neighbor cell list (442) does not adequately reflect available neighboring cell sites. . . . In such cases, the subscriber unit combines entries from its current neighbor cell list (451) with entries from the new neighbor cell list (442) obtained from the cell site to generate a supplemented neighbor cell list (652).” Ostroff, Abstract, emphasis added. As conceded by the Examiner in the Office Action mailed December 5, 2006 (Office Action of 12/5), “OSTROFF does not expressly disclose wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station.”

² Support for the amendments may be found, for example, at pages 24-26 of the specification and in original claim 2.

However, the Examiner alleges that “BONTA discloses wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station (paragraph 25; position of mobile device is used to determine the use of neighbor lists).” (Office Action of 12/5 at 4). Applicants respectfully disagree.

Bonta (U.S. Patent Application Publication No. 2002/0077103 to Bonta)³ explicitly states that “a neighbor list is optimized for grid element 17 to include only neighbors VI and VII rather than being tied to serving cell I.” Bonta, para. [0025]. However, Bonta’s choosing which station to be included in a neighbor list based on the location of the cell does not constitute “wherein the first neighbor list and the second neighbor list are combined without determining characteristics of the serving base station and corresponding cell,” as recited in amended claim 1 (emphasis added).

Further, as explained above, since Ostroff explicitly requires that “it determines whether characteristics of the cell site (428) is such . . . ,” (Ostroff, Abstract, emphasis added), Ostroff teaches away from the above listed elements of amended claim 1, and thus cannot be combined with other reference(s) under § 103(a) with respect to the above listed elements of amended claim 1.

The Examiner also alleges that “[t]he serving base station is changed to a standby mode which determines the use of a neighbor list. Furthermore, Figures 2 and 3 show that SIR of the active base station is measured and compared to candidate base station. In both instances, characteristics of the serving base station are determined.” (Office Action of 12/5 at 2.) Applicants respectfully disagree.

³ Although not applied in the current Office Action, Applicants discuss Bonta since it was applied in the Office Action of 12/5 against claim language similar to language added to claims 1 and 12 in the present Amendment.

Applicants' specification clearly states that "all peripheral base stations listed in the neighbor list NL_a and expanded neighbor lists NL_b and NL_c are searched unconditionally." Specification at page 24, lines 13-16, emphasis added. Therefore, at the time to determine which neighbor list to use, "the first neighbor list and the second neighbor list are combined without determining characteristics of the serving base station and corresponding cell," as recited in amended claim 1 (emphasis added). That is, the combined neighbor (i.e., used together) list is used to select a handoff destination candidate (thereby measuring the communication quality between the mobile terminal and base station (i.e., the hand-off destination candidate)). Therefore, amended claim 1 is sufficiently supported by the specification.

Further, the Examiner alleges that "OSTROFF further discloses wherein the memory stores the first neighbor list until a number of occasions in which selection for selecting the hand-off destination candidate is performed reaches a preset value (col. 5, line 64-67; first neighbor list is replaced when condition are deemed adequate." (Office Action at 4.) Applicants respectfully disagree.

In the cited paragraph, Ostroff states that "[w]hen a high site or other such condition does not exist to indicate inadequacy of the downloaded neighbor cell list, the current neighbor cell list is replaced by the downloaded neighbor cell list." Ostroff, column 5, lines 64-67. However, Ostroff's mere mentioning that a neighbor cell list is replaced with another does not constitute "the memory stores the first neighbor list until a total number of occasions in which selection for selecting the hand-off destination candidate is performed reaches a preset value, and the first neighbor list is erased from

the memory after the total number of occasions reaches the preset value,” as recited in amended claim 1 (emphasis added).

Horwath fails to cure the deficiencies of Ostroff. Horwath teaches “[a] method of automatically prioritizing cells in a neighbor list of a communication system. The priority is defined as the number of times a cell in the neighbor list has been added to the active set.” Horwath, Abstract, emphasis added. However, Horwath’s teaching of setting priority based on the number of times being added does not constitute the above listed elements of amended claim 1.

Therefore, neither Ostroff nor Horwath, taken alone or in any reasonable combination, teaches or suggests all elements required by amended claim 1. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of amended claim 1. Because claim 2 has been canceled, the Section 103(a) rejection of claim 2 is moot.

Further, amended independent claim 12, while of different scope, includes similar recitations to those of amended claim 1. Amended claim 12 is therefore also allowable for at least the same reasons stated above with respect to amended claim 1. Applicants respectfully request withdrawal of the Section 103(a) rejection of amended claim 12.

Applicants respectfully traverse the Examiner’s rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Horwath and further in view of Wallstedt, because a *prima facie* case of obviousness has not been established.

Claim 3 depends from claim 1. As set forth above, Ostroff and Horwath fail to teach or suggest, at least, “wherein the first neighbor list and the second neighbor list are combined without determining characteristics of the serving base station and

corresponding cell, and the memory stores the first neighbor list until a total number of occasions in which selection for selecting the hand-off destination candidate is performed reaches a preset value, and the first neighbor list is erased from the memory after the total number of occasions reaches the preset value," as recited in amended claim 1 (emphasis added).

Wallstedt fails to cure the deficiencies of Ostroff and Horwath. The Examiner alleges that "WALLSTEDT discloses wherein a memory stores a neighbor list for a preset time (col. 15, lines 23-col. 16, lines 2; col. 18, lines 8-48; memory updates the neighbor list according to a predetermined time)." (Office Action at 7.) Even assuming the Examiner's allegation is true, which Applicants do not concede, Wallstedt fails to teach or suggest at least the above listed claim elements as recited in amended claim 1 and required by claim 3.

Therefore, none of Ostroff, Horwath, and Wallstedt, taken alone or in any reasonable combination, teaches or suggests all elements required by claim 3. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 3.

Applicants respectfully traverse the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Horwath and further in view of Satarasinghe, because a *prima facie* case of obviousness has not been established.

Satarasinghe also fails to cure the deficiencies of Ostroff and Horwath. The Examiner alleges that "SATARASINGHE discloses wherein the pilot signal reception quality is measured (column 2:lines 25-45)" and "SATARASINGHE discloses wherein

the neighbor list is obtained by excluding the first peripheral base stations doubly listed as the second peripheral base stations in the second neighbor list (Figures 2 and 3; column 3:lines 16-67)." (Office Action at 8.) Even assuming the Examiner's allegation is true, which Applicants do not concede, Satarasinghe fails to teach or suggest at least the above listed claim elements as recited in amended claim 1 and required by claims 4 and 5.

Therefore, none of Ostroff, Horwath, and Satarasinghe, taken alone or in any reasonable combination, teaches or suggests all elements required by claims 4 and 5. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 4 and 5.

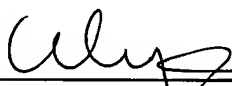
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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